

**REMARKS**

Claims 13-16 and 33-38 remain pending since it was indicated that they will be rejoined if the elected claims are found to be allowable. One new claim has been presented for consideration.

The Examiner is respectfully requested to consider the following remarks in conjunction with the arguments presented in the response dated 13 March 2008, and allow the application.

The Advisory Action did not comment on some of the arguments presented in the response of 13 March 2008, possibly because of space limitations. For those reasons, as amplified here, it is believed that the rejections should not be repeated.

The final rejection included a rejection of claims 1-12, 23, 24 and 26-32 under 35 USC § 102 over Fu. However, a previous Office Action correctly admitted the features of claims 4-9, 27, 30 and 31 were not present in Fu, and applicants cannot find any teaching of a cosmetic composition selected from the groups set forth in claim 26 of this application. Therefore, the inclusion of these claims in the anticipation rejection is not understood. Clarification (or non-repetition of this rejection) is respectfully requested.

As to the remaining aspects of the Section 102 rejection, applicants' arguments were based on the well established rule that a genus is not a disclosure of every unnamed species, *In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994), and that anticipation is not present when it is necessary to pick, choose and combine various portions of the disclosure when reading a claim on something disclosed in a reference. *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972); Accord, *Ex parte Beuther*, 71 USPQ2d 1313 (BPAI 2003) (Unpublished).

Applicants identified three selections which must be made among the possibilities in Fu's genus when trying to read Fu on the instant claims. The Advisory Action effectively only asserts that the invention can be reconstructed from the teaching of Fu but did not address these arguments.

Applicants also pointed out that the assertions made about physio-chemical properties such as gloss, etc., were addressing claims which were not present in this case. For example, no claim merely called for the coated synthetic mica to have a gloss. Instead, any claim referencing gloss also stated the gloss had a particular minimum value. Applicants also pointed out that any reliance on inherency required the characteristic to be certain, *In re Robertson*, 49 USPQ2d 1949, 1949 (Fed. Cir. 1999) ("inherency is not established by probabilities or possibilities"), and that requirement has not been met. Neither of these arguments were considered on the face of the Advisory Action.

In light of the foregoing, it is respectfully submitted that the Section 102 rejection was not tenable and should not be repeated. Any recasting of the rejection under Section 103 requires that the described surprising, unexpected and unpredictable results be considered, which has not been done to date. For instance, the invention is based, *inter alia*, on the discovery that improved transparency, superior gloss, glint and brightness, better compressibility and higher purity, as indicated by a higher degree of whiteness, can be realized by employing a synthetic mica having a particle size of about 150 to 1000 microns as the substrate. If the rejection's assumption that natural and synthetic micas are equivalent was correct, then the same improvement would be realized in both case, but it is not. Improvements realized with large particle size synthetic mica were not realized with natural mica.

Indeed, the large particle size synthetic mica gave better properties than the preferred small particle size natural mica of Fu.

With respect to the rejection of claims 1-12, 23, 24 and 26-32 under 35 USC § 103 over Fu combined with Calello, there is nothing in either reference, or any of the other cited art, which suggests changing the particle size of synthetic micas might overcome the deficient gloss and brightness properties. The Examiner had stated that Fu was being relied upon to show that particle size has a relationship to gloss or shine or texture and applicants responded that there is no such teaching or suggestion in Fu as of any type of mica, and particularly with respect to large size synthetic mica. The Advisory Action did not address or cure this lack of disclosure in the art. Calello was not cited to remedy this deficiency.

Applicants pointed to a fatal flaw in the rejection of claims 1-12, 17, 18, 23, 24 and 26-32 over Fu in view of Watanabe in that Examiner had acknowledged that Fu fails to disclose a composition having an increased transparency of at least 10%, and neither reference teaches or suggests that a large particle size synthetic mica will provide improved transparency. The Advisory Action did not cure this lack of disclosure in the art.

As to the rejection of claims 1, 18, 19 and 31 over Fu in view of Kimura, the Examiner acknowledged that Fu fails to disclose a composition in which a synthetic mica having an increased brightness of at least 5%, and Kimura fails to teach or suggest that a large particle size synthetic mica will provide improved brightness. Again, the Advisory Action did not indicate how this lack of disclosure or suggestion is overcome.

In the statement of the rejection of claims 1, 21, 22 and 25 over Fu in view of Miyoshi, it was acknowledged that Fu fails to disclose a composition with synthetic fluorphlogopite mica. Miyoshi was asserted to disclose a powder of substrate particles such as synthetic fluorphlogopite mica coated with micronized metal oxide particles. However, the Miyoshi substrate's particle size is 1-50  $\mu\text{m}$  (col. 3., lines 14-20) and Fu's most preferred range is 5-50  $\mu\text{m}$ , and applicants pointed out that that both references suggest the maximum particle size should be 50  $\mu\text{m}$ . Also pointed out was the lack of any teaching or suggestion that the use of the use of the coated large particle size synthetic mica will provide surprising, unexpected, and unpredictable properties compared to the use of a coated small or large particle size natural mica, or small particle size synthetic mica, shown in the application. The Advisory Action did not address either of these matters.

Several prior rejections are predicated on an assumption that if a property is desirable, the art inherently teaches it is present. That approach ignores the fact that the claims here do not merely indicate a property is present but recite a value of that property. The required proper basis (i.e., certainty) for asserting that the claimed values of the properties are inherent is present. Moreover, "a retrospective conclusion that an unstated advantage would follow from the suggested combinations is not a substitute teaching or suggestion which supports the selection and use of the various elements in the particular claim combination.... "That which may be inherent is not necessarily known.'" *In re Newell* 13 USPQ2d 1248 (Fed Cir 1989). The Advisory Action did not attempt to justify this improper assertion of inherency.

The Advisory Action does not address the traversal of the Section 112 rejection. It is believed that traversal was correct and the rejection should not be repeated.

In view of all of the foregoing, applicant believes the pending application is in condition for allowance.

Dated: August 8, 2008

Respectfully submitted,

By /Edward A. Meilman/  
Edward A. Meilman

Registration No.: 24,735  
DICKSTEIN SHAPIRO LLP  
1177 Avenue of the Americas  
New York, New York 10036-2714  
(212) 277-6500  
Attorney for Applicant